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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,046	09/30/2003	Michael P. Whitman	11443/158	7736

26646 7590 05/31/2005

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/676,046

Applicant(s)

WHITMAN, MICHAEL P.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/19&amp; 6/21/04, 5/09/05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Drawings***

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because they do not comply with 37 CFR 1.84. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Specification***

2. The disclosure is objected to because of the following informalities: U.S. Pat. Application numbers on pages 10, 17 and 19 should be updated (i.e., patent numbers).

Appropriate correction is required.

***Claim Objections***

3. Claim 74 is objected to because of the following informalities: in claim 74, line 2, "an" should be inserted between "to" and "irrigation/aspiration". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 2, 16, 21, 28, 31, 55, 57, 74 and 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 2, 31 and 57, the phrase “configured as an endoscope” is indefinite since it is unclear as to how this phrase further limits the previously claimed structure. Calling a structure an “endoscope” does not convey, in any specific manner, definite structure but only implies its intended use.

As to claim 16, term “video processor” lacks antecedent basis.

As to claim 21, term “power module” lacks antecedent basis.

As to claim 28, 55 and 82, the phrase “configured as one of a proctoscope and an anoscope” is indefinite since it is unclear as to how this phrase further limits the previously claimed structure. Calling a structure a “proctoscope” or “anoscope” does not convey, in any specific manner, definite structure but only implies its intended use.

As to claim 74, term “irrigation/aspiration channel” lacks antecedent basis.

#### ***NOTE***

6. It is noted that the references applied below to the claims were chosen to maximize the number of claims that could be met by any particular reference. The ridiculously overly broad claims can be met with myriad references, or combinations of such references, some of which are cited at the end of this Office Action. Thus, due to time constraints, only the minimum number of references that set forth the Office’s position will be applied. However, Applicant is

strongly urged to figure out what he has invented and make the claim language reflect what is believed to be patentable, using the prior art of record as a guide.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 29-32, 35-64, and 67-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk et al. (WO 93/15648).

Wilk et al. disclose a shaft (14), an image capture device (CCD 90 or 152), a light source (26,34 or 160), a control module (12), and a power module (38) which can include a integrally housed power source (260, Fig.12). All components of Wilk et al. are “sterilizable” and “autoclavable” since everything is “sterilizable” and “autoclavable” (and the inherent size of the Wilk et al. device would allow for the device to fit inside any known machine for doing either). The shaft (14) is bendable using steering cables (72a,72b,74a,74b, Fig.2), and is thus flexible, and the steering cables are connected to motors (252,254, Fig.12). The light source and image capture device can be mounted at the distal end of the shaft (Figs.7 and 8) and the distal light source can include a second power source (158, Fig.8) at the distal end of the shaft. The control module includes a video processor (not numbered but inherent in the circuitry associated with the CCD for supplying the video monitor (32), page 7, last paragraph) and a integrally mounted display screen (32). The shaft includes channels (52a,52b,52c) which are capable of conveying

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fluid or providing suction (60c,60a). Any of these channels can permit the passable of tools through the shaft. The shaft further includes a data transfer cable (88, Fig.4) for transmitting data to the video processor. The control module includes a control unit (any one of the housing for manually manipulating the device, the joystick (104, Fig.5), the buttons shown on the side of the display (Fig.5), or any of the controls of the suction source, air source, water source or light source) and a controller (any one of the electrical or mechanical means that control the suction source, air source, water source and light source, the processing circuitry which delivers an image to the display, motors (252,254), wireless transmitter (156, Fig.8), etc.). Since almost anything can be hand-held, the device of Wilk et al. is configured to be. The device of Wilk et al. is intended to be placed within the body so, as best understood, it is configured as an endoscope, proctoscope and anoscope.

### *Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-28, 33, 34, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk et al. in view of Kanno et al. (U.S. Pat. 4,884,133).

Wilk et al. disclose the elements as set forth above but including a light source but fails to specify the nature of the light source. Kanno et al. demonstrates that is known to use an LED or

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an array of LEDs in an endoscope for providing illumination light (note 26G, 26R, 26B of Figure 1(c) for example). Since it is well known and well within the ordinary skill in the art to recognize the advantages of LEDs (e.g., low power requirements, small size, etc.) over normal incandescent lamps and use of LEDs in an endoscope for the same purpose Wilk et al. (i.e., illumination) has been previously contemplated, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used LEDs for the generic "light source" of Wilk et al.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is by no means an exhaustive list of relevant references.

Yabe (U.S. Pat. 4,895,138)

Wood et al. (U.S. Pat. 4,941,456)

Kanno et al. (U.S. Pat. 4,994,133)

Matsumoto et al. (U.S. Pat. 6,260,994)

Wilk et al. (U.S. Pat. 5,396,879)

Steinberg (U.S. Pat. 5,630,783)

Hasegawa et al. (U.S. Pat. 6,371,907)

Hirata et al. (U.S. Pat. 6,540,670)

Onishi et al. (U.S. Pat. 6,612,981)

Ouchi (U.S. Pat. 6,612,982)

Irion et al. (U.S. Pat. 6,648,816)

Adler (U.S. Pat. 6,692,430)

Banik et. al. (U.S. Pat. 6,770,027)

Hirata et al. (U.S. Pat. 6,796,939)

Okada (U.S. Pat. 6,802,809)

Murata et al. (US 2001/0051762)

Okada (US 2003/0018237)

Obata et al. (US 2003/0018238)

Konomura et al. (US 2003/0092965)

Motoki et al. (US 2003/0195389)

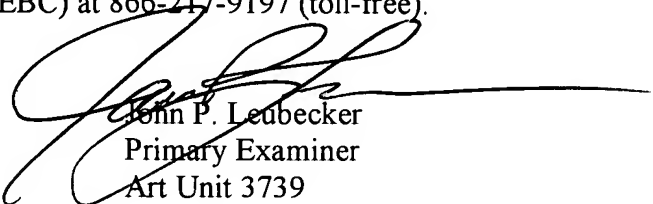
Hasegawa et al. (US 2004/0054259)

Miyake et al. (US 2004/0267095)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl